

REMARKS/ARGUMENTS

In the Claims:

Rejection of Claims Under 35 U.S.C. § 112

The Examiner rejected claims 110, 112 and 141-149 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description. More specifically, the Examiner asserts that use of the term “nonporous” in independent claim 110 is not supported by the original disclosure. Applicant has removed the term “nonporous” from claim 110. As each of claims 112 and 141-149 depend from claim 110, Applicant respectfully submits that the Examiner’s § 112 rejection is now moot.

Rejection of Claims 75, 78, 80, 85, 106, 107, 114, 115, 134, 135, 138, 152, 153 and 156 Under 35 U.S.C. § 102(b)

The Examiner rejected claims 75, 78, 80, 85, 106, 107, 114, 115, 134, 135, 138, 152, 153 and 156 under 35 U.S.C. § 102(b) as being anticipated by the Silipos Silosheath product. For the reasons set forth below, the rejection is respectfully traversed.

The present application is a continuation of Application No. 08/611,306, now US Patent No. 5,830,237 (the ‘237 patent). On February 27, 1998, during prosecution of the ‘237 patent, an in-person interview with the inventor and his attorney was entertained by the Examiner. During this interview, the Examiner was presented with and examined a Silipos Silosheath® as well as a commercial embodiment of the invention (i.e., the Luxury Liner). The Interview Summary

prepared by the Examiner subsequent to this interview is attached hereto. The

Examiner's description of the interview states:

The Applicant discussed the benefits of the instant invention over the Silosheath device in terms of comfort, fit of the prosthesis, and so on. Testimonials of various users were mentioned. The proposed claim 3 appears to distinguish over the Silosheath product.

In further support of the novelty of a liner of the '237 patent over the Silipos Silosheath[®], an inventor's declaration was filed on March 5, 1998. A copy of this declaration is attached hereto for the Examiner's convenience. The inventor's declaration pointed out several differences between the invention and the Silipos Silosheath[®]. These differences include, at least: (1) "With only gel on the inside, and fabric on the outside, the covering (liner) slides into a socket, even when the socket is tightly form fitting ..."; (2) "The Luxury Liner[®] integrates [a] total socket interface all in one product ... [while] other products like Silosheath[®] require additional layers of material, like wool socks, and pelite liners ..."; (3) "While standard thinking in the prosthetics industry is that less weight and less insulative effect is best, we have found that our gel characteristics are optimized by a higher level of thickness ..."

As pointed out in the inventor's declaration, a Silosheath[®] is not a cushion liner. Rather, the Silosheath[®] is a thin prosthetic sheath designed for use in conjunction with one or more layers of one or more other covering and cushioning materials.

Importantly, Applicant also showed the Examiner during the in-person interview that the Silipos Silosheath[®] product available at the time of invention had

an observable penetration of its gel material onto the outer surface of its fabric layer. Consequently, such a Silosheath[®] did not have fabric coated on *only an inside thereof* with a polymeric cushioning gel, as is recited in the rejected claims of the present application. It is clear that the Examiner considered this to be a novel distinction, as evidenced by the following Examiner's comments that appear on the Notice of Allowability¹ for the '237 patent:

A comparison was made of a Silopos Silosheath[®] and a model of the instant invention as claimed. The Silopos prosthetic sheath involves gel impregnation (as expressly stated in the accompanying product information leaflet) and possesses on one side a gel coating which is thinner than a gel coating on the opposite side. In the present tube-shaped covering, on the other hand, there is a gel coat on one side but no observable penetration of the gel through the fabric and onto the opposite side. Therefore, the claims are believed to patentably distinguish over the Silopos device. The Declaration under 37 CFR 1.132 of Bruce Kania has been considered and is also sufficient to overcome the rejection of claims based upon the Silosheath[®] of Silopos.

From the foregoing, it is clear that the Examiner allowed the '237 patent over the Silipos Silosheath[®]. As the present application is a continuation of the '237 patent, in which all claims are fully supported by the original description, rejected claims 75, 78, 80, 85, 106, 107, 114, 115, 134, 135, 138, 152, 153 and 156 of the present application should be allowable over the Silosheath[®] as well.

¹ A copy of the Notice of Allowability associated with the '237 patent is attached hereto for the Examiner's convenience.

Rejection of Claims 88, 89, 126, 127, 136, 137, 139, 140, 154, 155, 157 and 158
Under 35 U.S.C. § 103(a)

The Examiner rejected claims 88, 89, 126, 127, 136, 137, 139, 140, 154, 155, 157 and 158 under 35 U.S.C. § 103(a) as being unpatentable over the Silipos Silosheath[®]. Since Applicant does not believe the Silipos Silosheath[®] to qualify as prior art against the present claims, as discussed in detail above, claims 88, 89, 126, 127, 136, 137, 139, 140, 154, 155, 157 and 158 would also be allowable.

Rejection of Claims 76, 77, 80, 92-94, 96, 99, 102, 103, 107, 110, 111, 115, 118-121, 124, 125, 128-133, 141-151 and 159-165 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 76, 77, 80, 92-94, 96, 99, 102, 103, 107, 110, 111, 115, 118-121, 124, 125, 128-133, 141-151 and 159-165 under 35 U.S.C. § 103(a) as being unpatentable over the Silipos Silosheath[®] in view of Mushenko et al. Mushenko et al. does nothing to overcome the deficiencies of the Silosheath[®], as set forth above. Consequently, Applicant respectfully submits that the Silipos Silosheath[®] in view of Mushenko et al. cannot support a rejection of claims 76, 77, 80, 92-94, 96, 99, 102, 103, 107, 110, 111, 115, 118-121, 124, 125, 128-133, 141-151 and 159-165 under 35 U.S.C. § 103(a).

CONCLUSION

Applicant has amended claim 110 to overcome the Examiner's § 112 rejection. Applicant has also provided evidence that the parent to the present application was expressly allowed over the Silipos Silosheath[®], which product is necessary to each of the Examiner's remaining rejections.

Therefore, Applicant respectfully submits that the present application is now in condition for allowance, and entry of the present amendment and allowance of the application as amended is earnestly requested.

Telephone inquiry to the undersigned in order to clarify or otherwise expedite prosecution of the present application is respectfully encouraged.

Respectfully submitted,

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By: /Eric M. Gayan/

Eric M. Gayan
Attorney for Applicant
Registration No. 46,103
Standley Law Group LLP
495 Metro Place South
Suite 210
Dublin, Ohio 43017-5319
Telephone: (614) 792-5555
Facsimile: (614) 792-5536
E-mail: egayan@standleyllp.com